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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/649,477	08/26/2003	Michael Stilgenbauer	DKT02032	5383

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EXAMINER
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TRIEU, THAI BA

ART UNIT	PAPER NUMBER
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3748

DATE MAILED: 12/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/649,477

Applicant(s)

STILGENBAUER, MICHAEL

Examiner

Thai-Ba Trieu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 11-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-14, 18, 19, 21-25, 27, 28 and 31 is/are rejected.
- 7) ☒ Claim(s) 15-17, 20, 26, 29, and 30 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 09/29/2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

### **DETAILED ACTION**

Receipt is acknowledged of papers submitted under 35 U.S.C. 119 (a)-(d), which papers have been placed of record in the file.

The Preliminary Amendment filed on August 26, 2003 is acknowledged. Claims 1-10 were cancelled. Claims 1-21 were added.

Pursuant to rule 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

The examiner has renumbered newly added claims **1-21** as claims **11-31**. The rejections set forth below are based on the renumbered claims.

### ***Information Disclosure Statement***

The listing of references Having Patent Number WO 01/96713 and EP 0 226 444 A (See Page 1, Paragraph [0002], line 8; and Paragraph [0004], line 2) in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### ***Specification***

Since the abstract is too long, Applicant is required to submit a substitute abstract to meet the requirement set forth below (See Abstract filed on February 27, 2004).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet **within the range of 50 to 150 words**. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

### ***Claim Objections***

Claims 12-31 are objected to because of the following informalities:

- In claims 12-15, 18-21, line 1, "***according to claim 1***" should be replaced by – ***according to claim 11*** – (since claim 1 has been renumbered as claim 11).
- In claims 16-17, line 1, "***according to claim 5***" should be replaced by – ***according to claim 15*** – (since claim 5 has been renumbered as claim 15).
- In claim 22, line 1, "***according to claim 11***" should be replaced by – ***according to claim 21*** – (since claim 11 has been renumbered as claim 21).

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- In claims 24, 27, 29 and 31, line 1, ***"according to claim 13"*** should be replaced by – ***according to claim 23*** – (since claim 13 has been renumbered as claim 23).

- In claims 25 and 26, line 1, ***"according to claim 14"*** should be replaced by – ***according to claim 24*** – (since claim 14 has been renumbered as claim 24).

- In claim 28, line 1, ***"according to claim 17"*** should be replaced by – ***according to claim 27*** – (since claim 17 has been renumbered as claim 27).

- In claim 30, line 1, ***"according to claim 19"*** should be replaced by – ***according to claim 29*** – (since claim 19 has been renumbered as claim 29).

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

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Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

***Claims 11, 18-19, 21-25, and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Fukaya et al. (Patent Number 6,558,117 B1).***

**Regarding claim 11,** Fukaya discloses a turbocharger comprising:

a turbine housing (1), with

at least one supply channel means (Not Numbered) said housing (1) for supplying said exhaust gas (See Figure 1);

wherein at least one turbine rotor rotatably supported within said housing (1), said supply channel means being arranged to supply said exhaust gas to said turbine rotor (5) in order to rotate it (See Figure 1);

spacer means (3, 4) forming a passage of variable cross-section between said supply channel means (Not Numbered) and said turbine rotor (5) in order to control the amount of exhaust gas admitted to said turbine rotor (5) said means including:

a plurality vanes (2) predetermined width distributed in an annular vane space (Not Numbered) of approximately said width around said turbine rotor having two axial ends to form a passage between them for admitting exhaust gas to said turbine rotor (5) each vane (2) being pivoted about an axis to enable control of the amount of exhaust gas (See Figure 1),

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a vane support ring member (6) supporting said axes of said vanes (2),  
said vane support ring member (6) defining one axial end said annular vane  
space by a first circumferential surface (See Figure 1),

a housing ring (Not Numbered) facing and being spaced from said support  
ring member (6) by said width to define the other axial end of said annular vane  
space by a second circumferential surface (See Figures 2-3), and

wherein at least two spacer means (3, 4) integrally formed on at  
least one of said circumferential surfaces of ring members said housing  
ring (Not Numbered) or said support ring member (6), and being  
distributed over its respective circumferential surface to ensure said width  
of said vane space (See Figures 1-3, Column 3, lines 16-51).

**Regarding claims 18-19, 21-22, 24-25, and 31,** Fukaya further discloses said  
spacer means (3, 4) being elongated, vane-shaped (see Figures 1, 6, and 8); at least  
part of said spacer means (3, 4) having a bore (not Numbered) for passing a connection  
bolt (8) through (See Figure 1) and being connected to the opposite ring member (See  
Figure 2).

**Regarding claim 23,** Fukaya discloses a vane ring for a turbocharger  
comprising:

an annular surface on both sides of a vane support ring member (6);

a plurality of bores (wherein shafts 7 going through) distributed around the

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circumference of a passage in said annular surface for allowing passage of a plurality of vane (2) shafts (7);

wherein spacer means (3, 4) integrally formed on said annular surface are distributed over the circumference of said annular surface (See Figure 1).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

***Claims 12-14 and 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukaya et al. (Patent Number 6,558,117 B1).***

Fukaya discloses the invention as recited above, and further discloses at least one of said ring members (6) being of cast metal (See Column 8, lines 29-42) and said spacer means are formed in an outer circumferential border zone said circumferential surface of at least one of said ring members (See Figure 1); however, Fukaya fails to disclose said spacer means being integrally formed on said vane support ring member, said spacer means being integrally cast, and integrally formed in an outer circumferential border zone said circumferential surface of at least one of said ring members.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have said spacer means being integrally formed on said vane



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support ring member, said spacer means being integrally cast, and integrally formed in an outer circumferential border zone said circumferential surface of at least one of said ring members, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

### ***Allowable Subject Matter***

Claims **15-17, 20, 26, and 29-30** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

The IDS (PTO-1449) filed on September 29, 2004 has been considered. An initialized copy is attached hereto.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Boeing (Pub. Number 2004/0081567 A1) discloses a guiding grid of variable geometry and turbocharger.
- Knauer et al. (Pub. Number 2003/0170117 A1) disclose a turbocharger for vehicle with improved suspension of the actuating mechanism for variable nozzles.
- Swihart et al. (US Patent Number 4,679,984) disclose an actuation system for variable nozzle turbine.

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- Burdette et al. (US Patent Number 4,654,941) disclose a method of assembling a variable nozzle turbocharger.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thai-Ba Trieu whose telephone number is (571) 272-4867. The examiner can normally be reached on Monday - Thursday (6:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas E. Denion can be reached on (571) 272-4859. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TTB  
December 1, 2004

  
Thai-Ba Trieu  
Patent Examiner  
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